

REMARKS

The claims have been amended by incorporating the subject matter of claim 5 into the independent claims. The claims have further been amended for purposes of clarity. Entry of the amendment is respectfully requested.

Review and reconsideration on the merits are further requested.

Claims 1 and 3-26 have been rejected under the judicially created doctrine of obviousness-type double patenting as obvious over claims 1-21 of U.S. Patent Number 6,602,156 to Schlueter, Jr. In response, Applicants traverse the rejection.

The claims of the '156 patent relate to an endless seamed flexible belt having a substrate, and having a seam comprising an adhesive comprising a polyamide and a doped metal oxide filler. Applicants respectfully submit that one of ordinary skill in the art would not have been motivated to remove the doped metal oxide filler from the polyamide and expect the same or similar results. The present claims do not recite the presence of a doped metal oxide filler. Applicants submit that doped metal oxide fillers provide specific results in terms of mechanical and electrical characteristics. One of ordinary skill in the art would not have expected to obtain the same or similar results without the presence of the doped metal oxide in view of the teachings of the claims of '156.

In addition, Applicants submit that the claims of '156 do not recite an alcohol-soluble polyamide adhesive as claimed in the present claims. Absent some teaching or suggestion, Applicants submit that one of ordinary skill in the art would not have been motivated to use the claimed alcohol-soluble polyamide adhesive having the structure of former claim 5.

In view of the above arguments, Applicants submit that the present claims are not obvious over the claims of '156, and respectfully request withdrawal of the rejection of claims 1 and 3-26 under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1-21 of U.S. Patent Number 6,602,156.

Claims 1 and 3-26 have been rejected under the judicially created doctrine of obviousness-type double patenting as obvious over claims 9-17 of U.S. Patent Number 5,997,974 to Schlueter, Jr. in view of U.S. Patent Number 6,602,156 to Schlueter, Jr. In response, Applicants traverse the rejection.

Claims 9-17 of '974 relate to a process for fabricating an endless seamed belt. The process includes bonding a material in the gap between the surfaces and providing an undercoating layer covering the substrate and the bonded seams such that the belt surface including the bonded seam is substantially smooth. There is no teaching or suggestion in claims 9-17 of the use of an alcohol-soluble polyamide having the claimed structure, formerly of claim 5. Applicants submit that one of ordinary skill in the art would not have been motivated to recite the claimed endless seamed flexible belt having an alcohol-soluble polyamide adhesive, in view of the teachings of a reference teaching a method for forming an endless flexible seamed belt by providing an undercoating layer covering the substrate, and bonding that seam such that the belt surface is substantially smooth, and further in view of a reference teaching a polyamide and doped metal oxide filler adhesive. The present claims are not related to a process, and instead, are related to an endless seamed flexible belt. In addition, neither the claims of '156 nor the claims of '974 teach or suggest an alcohol-soluble polyamide adhesive, or the specifically recited alcohol-soluble polyamide of former claim 5.

Therefore, Applicants submit that the present claims are not rendered obvious in view of the claims of the cited patents. Accordingly, Applicants request withdrawal of the rejection of claims 1 and 3-26 under the judicially created doctrine of obviousness-type double patenting as obvious over claims 9-17 of U.S. Patent Number 5,997,974 to Schlueter, Jr. in view of U.S. Patent Number 6,602,156 to Schlueter, Jr.

Claims 1 and 3-26 have been provisionally rejected on the grounds non-statutory obviousness-type double patenting as being unpatentable over claims 1, 4, 6, 8-11, 13-18, and 21-25 of copending Application Serial Number 10/014,452. In response, Applicants traverse the rejection.

The claims of the referenced application relate to an endless seamed flexible belt having a seam, wherein the seam comprises a polymer and a plasticizer other than the plasticizers listed in the claim. Although the claims cite a polyamide adhesive, the claims do not recite that the polyamide adhesive is alcohol-soluble as claimed in the present claims. Also, the specific polyamide of former claim 5 is not recited. Applicants submit that one of ordinary skill in the art would not have been motivated to remove the plasticizer of the

claimed seam of the cited application, and then change the adhesive to an alcohol-soluble polyamide adhesive of former claim 5 in view of the teachings of the claim.

Accordingly, Applicants submit that the present claims are not obvious in view of the referenced application. Applicants request withdrawal of the provisional rejection of claims 1 and 3-26 on the grounds of non-statutory obviousness-type double patenting as being obvious over claims 1, 4, 6, 8-11, 13-18, and 21-25 of copending Application Serial Number 10/014,452.

Claim 4 has been objected to for use of the phrase "methylene methoxy." Applicants provide page 368 of Grant and Hackh's Chemical Dictionary, which recites the term methylene as a carbene or methene and can be used instead of the term methyl. Therefore, Applicants respectfully request withdrawal of the objection of claim 4 as the term is correctly used.

Claims 19-20 have been rejected because of missing superscripts. Applicants have amended those claims to reinsert the superscript. Applicants appreciate the Examiner pointing out this error. In view of the corrections to claims 19 and 20, Applicants request withdrawal of the objections.

Claims 1, 7-11, 14, 17 and 19-25 have been rejected under 35 USC §102(b) as anticipated by Schlueter, Jr. (5,997,974, hereinafter, Schlueter Jr. '974) as evidenced by Fuller, et al. In response, Applicants traverse the rejection.

Applicants respectfully submit that neither reference teaches or suggests amended claim 1 which now includes the recitations of former claim 5, that of the specific alcohol-soluble polyamide of former claim 5. Because neither reference teaches or suggests the claimed alcohol-soluble polyamide, Applicants submit that the present claims are not rendered obvious in view of the cited references.

As a side note, Applicants note that the Examiner states that all polyamides are alcohol-soluble. Applicants submit herewith a 1449 and copy of U.S. Patent Number 4,340,480 which is a process for preparing alcohol-insoluble polyamides. In fact, most polyamides are insoluble depending on their molecular weight. Also, branched-chain polyamides are less soluble in solvents, including alcohol. Aliphatic are more soluble. Applicants note that a quick search in chemical records, chemical patents, or on the internet,

will provide ample evidence of alcohol-insoluble polyamides. Applicants respectfully disagree that all polyamides are alcohol-soluble and provide evidence that there are alcohol-insoluble polyamides.

Applicants further point out once that Fuller, et al. does not teach an alcohol-soluble polyamide adhesive. Instead, the reference teaches polyester, polyurethane and other adhesives, and does not recite alcohol-soluble polyamides. Instead the reference teaches that one or more layers of a photoreceptor may comprise an alcohol-soluble polyamide.

In view of the above arguments and amendments, Applicants respectfully submit that the present claims are not rendered obvious in view of the cited combination. Accordingly, Applicants request withdrawal of the rejection of claims 1, 7-11, 14, 17 and 19-25 under 35 USC §102(b) as anticipated by Schlueter, Jr. (5,997,974, hereinafter, Schlueter Jr. '974) as evidenced by Fuller, et al.

Claims 1, 17 and 19-24 have been rejected under 35 USC §103 as obvious over Parker, et al. in view of Nakata, et al. In response, Applicants traverse the rejection.

Applicants respectfully submit that neither reference teaches or suggest the claimed alcohol-soluble polyamide which has been inserted into claim 1. In view of the fact that neither reference teaches or suggests the claimed alcohol-soluble polyamide, Applicants respectfully submit that the present claims are not rendered obvious in view of the cited combination. Applicants submit that absent some teaching or suggestion, one of ordinary skill in the art would not have been motivated to use the claimed alcohol-soluble polyamide having the formula set forth in amended claim 1. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1, 17 and 19-24 under 35 USC §103 as obvious over Parker, et al. in view of Nakata, et al.

Claims 1, 3-4, 7, 9, 14, 17, and 19-25 have been rejected under 35 USC §103 as obvious over Parker, et al. in view of Renfer, et al. In response, Applicants traverse the reference.

Applicants submit that neither reference teaches or suggests the alcohol-soluble polyamide of claim 1. Applicants submit that absent some teaching or suggestion to use the specific alcohol-soluble polyamide of the formula of claim 5 which has been inserted into claim 1, one of ordinary skill in the art would not have been motivated to use the specific

polyamide. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1, 3-4, 7, 9, 14, 17, and 19-25 under 35 USC §103 as obvious over Parker, et al. in view of Renfer, et al.

Claims 3-4 have been rejected under 35 USC §103 as obvious over Schlueter, Jr. '974 as evidenced by Fuller, et al. and further in view of Renfer, et al. In response, Applicants traverse the rejection.

Applicants again point out that claim 1, from which claims 3 and 4 depend, now recites the specific polyamide of claim 1. None of the references cited teach or suggest the specific polyamide of claim 5. Therefore, absent some teaching or suggestion, Applicants submit that one of ordinary skill in the art would not have been motivated to use the specific alcohol-soluble polyamide of amended claim 1. Accordingly, Applicants submit that the present claims are not obvious in view of the cited combination, and respectfully withdrawal of the rejection of claims 3-4 under 35 USC §103 as obvious over Schlueter, Jr. '974 as evidenced by Fuller, et al. and further in view of Renfer, et al.

Claims 13 and 15-16 have been rejected under 35 USC §103 as obvious over Schlueter, Jr. '974 as evidenced by Fuller, et al. and further in view of Fuller, et al. In response, Applicants traverse the rejection.

Applicants are confused by the rejection as Fuller, et al. is used twice in the rejection. However, Applicants theorize that the rejection is a rejection of claims 13 and 15-16 over Schlueter, Jr. '974 in view of Fuller, et al. Applicants traverse the rejection and submit that neither reference teaches or suggests the specific alcohol-soluble polyamide that has been inserted into claim 1 from which the rejected claims ultimately depend. Applicants submit that absent some teaching or suggestion, one of ordinary skill in the art would not have been motivated to use the specifically recited polyamide as claimed. Accordingly, Applicants submit that the present claims are not rendered obvious in view of the cited combination, and respectfully request withdrawal of the rejection of claims 13 and 15-16 under 35 USC §103 as obvious over Schlueter, Jr. '974 as evidenced by Fuller, et al. and further in view of Fuller, et al.

Claim 12 has been rejected under 35 USC §103 as obvious over Schlueter, Jr. '974 as evidenced by Fuller, et al. and further in view of Sakakibara, et al. In response, Applicants traverse the rejection.

Applicants point out that claim 12 ultimately depends from claim 1, which now includes the recitation of former claim 5. Applicants submit that absent some teaching or suggestion, one of ordinary skill in the art would not have been motivated to use the specific polyamide of claim 5, which has now been incorporated into claim 1. Accordingly, Applicants submit that the present claim is not rendered obvious in view of the cited combination, and respectfully request withdrawal of the rejection of claim 12 under 35 USC §103 as obvious over Schlueter, Jr. '974 as evidenced by Fuller, et al. and further in view of Sakakibara, et al.

Claim 18 has been rejected under 35 USC §103 as obvious over Schlueter, Jr. '974 as evidenced by Fuller, et al. and further in view of Yuan, et al. In response, Applicants traverse the rejection.

Applicants point out that claim 18 ultimately depends from claim 1, and that claim 1 now includes the recitation of the alcohol-soluble polyamide of claim 5. Applicants submit that absent some teaching or suggestion, one of ordinary skill in the art would not have been motivated to use the specific alcohol-soluble polyamide of claim 5. Accordingly, Applicants submit that the present claim is not rendered obvious in view of the cited combination, and respectfully request withdrawal of the rejection of claim 18 under 35 USC §103 as obvious over Schlueter, Jr. '974 as evidenced by Fuller, et al. and further in view of Yuan, et al.

Claim 18 has been rejected under 35 USC §103 as obvious over Parker, et al. in view of Nakata, et al. or optionally in view of Renfer, et al., and further in view of Yuan, et al. In response, Applicants traverse the rejection.

Applicants submit that none of the references teaches or suggests the alcohol-soluble polyamide of amended claim 1. Absent some teaching or suggestion, one of ordinary skill in the art would not have been motivated to use the claimed alcohol-soluble polyamide. Therefore, Applicants submit that the present claim is not rendered obvious in view of the cited combination, and respectfully request withdrawal of the rejection of claim 18 under 35 USC §103 as obvious over Parker, et al. in view of Nakata, et al. or optionally in view of Renfer, et al., and further in view of Yuan, et al.

Claims 1, 17 and 19-24 have been rejected under 35 USC §103 as obvious over Parker, et al. in view of Shishido, et al. and further in view of Okunuki, et al. In response, Applicants traverse the rejection.

Applicants point out that none of the references teach or suggest the alcohol-soluble polyamide of claim 5, which has now been incorporated into claim 1. Accordingly, Applicants submit that absent some teaching or suggestion, one of ordinary skill in the art would not have been motivated to use the claimed alcohol-soluble polyamide. Therefore, Applicants submit that the present claims are not rendered obvious in view of the cited combination, and respectfully request withdrawal of the rejection of claims 1, 17 and 19-24 under 35 USC §103 as obvious over Parker, et al. in view of Shishido, et al. and further in view of Okunuki, et al.

Claims 3-4, 7, 9, 14 and 25 have been rejected under 35 USC §103 as obvious over Parker, et al. in view of Shishido, et al. and in view of Okunuki, et al. and further in view of Renfer, et al. In response, Applicants traverse the rejection.

Applicants submit that none of the references cited teach or suggest the alcohol-soluble polyamide of claim 1 from which the rejected claims depend or include. Absent some teaching or suggestion, Applicants submit that one of ordinary skill in the art would not have been motivated to use the specifically claimed alcohol-soluble polyamide, and submit that the present claims are not rendered obvious in view of the cited combination. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 3-4, 7, 9, 14 and 25 under 35 USC §103 as obvious over Parker, et al. in view of Shishido, et al. and in view of Okunuki, et al. and further in view of Renfer, et al.

Claim 18 has been rejected under 35 USC §103 as obvious over Parker, et al. in view of Shishido, et al. and in view of Okunuki, et al. and further in view of Yuan, et al. In response, Applicants traverse the rejection.

Applicants submit that none of the references cited teach or suggest the claimed alcohol-soluble polyamide. Absent some teaching or suggestion, Applicants submit that one of ordinary skill in the art would not have been motivated to use the claimed alcohol-soluble polyamide. Accordingly, Applicants submit that the present claims are not rendered obvious in view of the cited combination, and respectfully request withdrawal of the rejection of claim

18 under 35 USC §103 as obvious over Parker, et al. in view of Shishido, et al. and in view of Okunuki, et al. and further in view of Yuan, et al.

Applicants appreciate the indication that claims 5 and 6 are allowed.

In view of the above arguments, Applicants submit that all claims should now be in condition for allowance. Early indication of allowability is respectfully requested.

No additional fee is believed to be required for this amendment. However, the undersigned Xerox Corporation attorney (or agent) hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025. This also constitutes a request for any needed extension of time and authorization to charge all fees therefor to Xerox Corporation Deposit Account No. 24-0025.

In the event the Examiner considers personal contact advantageous to the disposition of this case, s/he is hereby authorized to call Applicant's Attorney, Annette L. Bade, at telephone number (310) 333-3682.

Respectfully submitted,



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May 19, 2006
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